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A 831.10(3)

EXAMINER

BENNETT.C

FSM1/0418

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ART UNIT

PAPER NUMBER

9

3307

DATE MAILED:

04/18/95

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 11/17/95 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                   |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/>  |

Part II SUMMARY OF ACTION

1. ☒ Claims 2,3,5,6 are pending in the application.  
Of the above, claims — are withdrawn from consideration.
2. ☒ Claims 1,4,7-15 have been cancelled.
3. ☒ Claims 5,6 are allowed.
4. ☒ Claims 2,3 are rejected.
5. ☐ Claims — are objected to.
6. ☐ Claims — are subject to restriction or election requirement.
7. ☐ This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on —. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on — has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on —, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. —; filed on —.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --*

*(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

*(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.*

**Claim 2 is rejected under 35 U.S.C. § 102(b) as being anticipated by Smith ('891).**

Lazarus teaches a method of dilating an incision comprising inherently inserting a stylet for guide wire 33; providing a first tube 20; providing a second tube 11 having a length greater than said first tube 94; dimensioning said first tube 20 to telescopically receive said second tube 84 therewithin; tapering a distal end of said second tube 11 (see reference numeral 13); said first and second tubes 20 and 11 forming a dilator means when in said second tube 11 is inserted within said first tube 20; inserting said dilating means; dilating said incision a first amount by inserting the tapered end 13 of the second tube 11; dilating said incision further by inserting the first tube 20; and withdrawing said second tube 11 from within said first tube 20.

**Claims 3 is rejected under 35 U.S.C. § 102(e) as being anticipated by Baumgartner ('021).**

Baumgartner teaches a device comprising: a base member 16 having a predetermined diameter; an elongated hollow tube 12 fixedly secured to said base member 16; a common bore means as seen in fig. 1 formed in said tube and base member; a recess as seen in fig. 2 formed in a trailing edge of said base member 16 having a diameter slightly less than said predetermined diameter; a water port 17 formed in said base member 16 including a bore means formed therein in fluid communication with the bore means common to said tube and base member; and recess means at the proximal end of the base member (see fig. 2); said base member having a predetermined depth. It is noted that the claims have been evaluated with respect to the prior art based upon the structure which has been positively recited; the name given to the device, i.e. "a dilator tube" is not given patentable weight. Furthermore, the tube 12 of Baumgartner would inherently dilate an incision in a patient when said tube is inserted.

**Claims 5 and 6 are allowable over the prior art of record.**

Applicant's arguments filed 17 January 1995 have been fully considered but they are not deemed to be persuasive.

With respect to page 4, the first paragraph, "tube 12 of Baumgartner is never used alone...the device of Fig. 3 must be used therewith." In response, it is noted that apparatus claims are evaluated based on the structure recited in the claims, not the method of using the apparatus and therefore, it is irrelevant whether the tube is used alone or not. Further, the tube 12 of Baumgartner is clearly an open-ended hollow tube as been in Fig. 2.

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With respect to page 4, the third paragraph, applicant states "Baumgartner is solid and that its interior is therefore not in open fluid communication with the bore..." The Examiner points out that this is clearly not the case as seen in figs. 1 and 2, the base 16 has a recess which is in fact in communication with the bore of tube 12.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Chris A. Bennett, whose telephone number (703) 308-0980.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858.

The fax number for this group is (703) 305-3590, 91.

  
**CHRIS A. BENNETT**  
**PATENT EXAMINER**  
**GROUP 3300**

CAB  
April 17, 1995